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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 85804-010801	
I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to Examiner James W. Myhre, Art Unit 3622, United States Patent and Trademark Office, Facsimile No. (571) 273-8300. on <u>February 22, 2006</u> Signature <u>Suzanne Marx</u> Typed or printed name <u>Suzanne Marx</u>		Application Number 10/696,295	Filed October 28, 2003
		First Named Inventor Lawrence Morrisroe, et al.	
		Art Unit 3622	Examiner James W. Myhre
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,000</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>Carole A. Quinn</u> Typed or printed name <u>(714) 708-6500</u> Telephone number <u>February 22, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>-3-</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.5. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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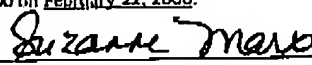
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lawrence Morrisroe, et al. Examiner: James W. Myhre
Serial No. 10/696,295 Group Art Unit: 3622
Filed: October 28, 2003 Docket No. 85804-010801
Title: Method and System for Creating, Serving and Tracking Advertisements
Customer No.: 32361

CERTIFICATE UNDER 37 CFR 1.6(d)

I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to Examiner James W. Myhre, Art Unit 3622, United States Patent and Trademark Office, Facsimile No. (571) 273-8300 on February 22, 2006.


Name: Suzanne MarxLETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Date: February 22, 2006

MAIL STOP AF
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This paper is being filed with a Request For Pre-Appeal Brief Review and a Notice of Appeal.

REMARKS

Applicants seek formal review by a panel of examiners of the 35 U.S.C. § 103(a) rejection of the pending claims (i.e., Claims 1 to 28 and 31 to 33) in an Office Action mail dated June 16, 2005 (hereinafter referred to as the "previous Office Action"), which rejection was made final in the Office Action mail dated November 22, 2005 (hereinafter referred to as the "current Office Action"). Review of the § 103(a) rejection is requested. In this regard, Applicants' remarks made herein supplement the remarks submitted with Applicants' Amendment and Response

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dated October 17, 2005 (hereinafter referred to as Applicants' "previous remarks"). For at least the reasons set forth herein and in Applicants' previous remarks, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file to create an integrated ad file containing computer code for providing the ad. The ad input file identifies the content of the ad and the conduit file identifies tracking data for the ad. The integrated ad file is served from a computer to provide the ad.

As in the previous Office Action, the current Office Action concedes that Reilly fails to disclose combining an ad input file and a conduit file to create an integrated ad file. In an apparent effort to address those deficiencies noted in the previous Office Action and pointed out in Applicants' previous remarks, the current Office Action states (at page 6):

"[t]he Examiner first notes that the claimed 'integrated ad file' according to the claims and Applicants' arguments consists of at least two files – an ad input file and a conduit file. While the Applicant is calling [an integrated ad file] a file, it is better known in the hierarchical files [sic] system art as a folder."

The Office Action then cites, for the first time, the Microsoft Press Computer Dictionary, Third Edition (pp. 202-203), and the definition of a "folder" contained therein¹.

Applicants submit that the Office Action mischaracterizes the language of the claims and Applicants' previous remarks. As the claim recites, the ad input file identifies the content of the ad and the conduit file identifies tracking data for the ad. It is respectfully submitted that the Examiner has read these limitations out of the claim. In fact, and as evidenced by the above quotation, the current Office Action apparently attempts to change the claim language in an attempt to buttress the rejection originally made in the first Office Action.

For this reason alone, the § 103(a) rejection should be withdrawn. Notwithstanding this and as a further basis for withdrawal of the rejection, there is nothing in the definition of a

¹ The Office Action suggests that this new art is being introduced to rebut Applicants' traversal of Official Notice taken in the previous Office Action. Rather, the Office Action introduces the new art in an apparent attempt to support the new issues raised in the Office Action, as evidenced by the above quote from the Office Action. The new issues are being raised for the first time in the current Office Action. Accordingly, it is submitted that the Office Action should not have been made final. See MPEP §§ 706.07, 706.07(a) and 2144.03, for example.

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"folder" as provided in the Microsoft Press Computer Dictionary, which would even suggest that a "folder" and a "file" are equivalent. Rather, the definition supports the conclusion that a folder is different than a file, and is certainly not the same as an "integrated ad file". Further, nothing in the cited "folder" definition discloses or even suggests combining an ad input file and a conduit file to create an integrated ad file.

Claim 11 recites a method of facilitating providing an ad by loading an ad file. According to the method, first and second files are identified. A placeholder is identified in the first file, and the second file is electronically inserted into the placeholder to create the ad file. The ad file includes computer code for providing the ad.

Independent Claim 11 (as well as independent Claims 16 and 24) recite the feature of identifying a placeholder in a first file, and electronically inserting a second file into the placeholder identified in the first file, to create an ad file. With regard to Applicants' previous remarks concerning the absence of any disclosure in Reilly of this feature, the Examiner responds and cites col. 9, line 65 to col. 10, line 19 and col. 13, lines 61 to 64 of Reilly.

However, col. 9, lines 65 to col. 10, line 19 of Reilly contains a description of a display script which controls the display of images on a display screen, such that the images can remain in a static location on the display screen or can appear to move around the display screen. A script, which when executed, controls display images on a display screen cannot be said to be the same as a placeholder contained in a file. Further, nothing in the cited portion describes or even suggests identifying a placeholder in a first file, and inserting a second file into the placeholder identified in the first file to create an ad file.

Similarly, at col. 13, lines 61 to 64, Reilly describes a display screen of a data viewer program, a portion of which is used to display an advertisement image. This cannot be said to be the same as placeholder in a first file, into which placeholder of the first file a second file is inserted to create an ad file.

Finally, the current Office Action, at page 7, contends that the combination of two or more files into a folder was well known, and that it would have been an obvious method of transmitting the plurality of files in Reilly. However and even assuming that this accurately reflects the state of the art at the time of the claimed invention (a fact that is in no way conceded by Applicants, and indeed there has been no such showing), there has been no showing of a

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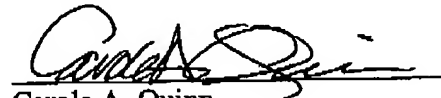
motivation or suggestion to modify Reilly in the manner suggested in the Office Action.² Since such a showing is necessary in order to establish a prima facie case of obviousness under § 103(a), the current rejection is legally deficient. Moreover, even if such an improper combination were made it would not yield the claimed invention, as the deficiencies present in each reference are not cured by the hypothetical combination, as neither reference teaches, suggests or describes the claimed elements yielding an ad file.

Accordingly, based on the remarks made herein, together with Applicants' prior remarks, it is submitted that the legal and factual requirements under 35 U.S.C. §§ 103 have not been met. Withdrawal of the 35 U.S.C. §§ 103 rejection of pending Claims 1 to 28 and 31 to 33 is therefore appropriate, and is respectfully requested.

No additional fee is believed to be necessary. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2638. Please ensure that the Attorney Docket Number is referenced when charging payments or credits for this case.

Respectfully submitted,

Date: February 22, 2006


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² Applicants wish to point out that, despite any suggestion that may be made at page 3 of the current Office Action, Applicants' previous remarks in no way concede that Reilly states a motivation "to combine files", let alone "to combine files ... to enable the client computer to more easily identify the correlation between the files and in order to facilitate time efficient transmissions. Rather, Applicants' previous remarks referenced by the Office Action merely acknowledge Reilly's use of compression to reduce the size of data, such as an image, in order to make download transmission as time efficient as possible. In this regard, Applicants' previous remarks are set out in full at page 12 of the October 17, 2005 Amendment and Response.